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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,777	03/05/2002	Bon-Seuk Goo	P56672	8814

7590 01/30/2006

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EXAMINER

PHAN, MAN U

ART UNIT	PAPER NUMBER
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2665

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/087,777	<b>Applicant(s)</b> GOO ET AL.	
	<b>Examiner</b> Man Phan	<b>Art Unit</b> 2665	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/26/04</u> . | 6) <input type="checkbox"/> Other: _____  |

***DETAILED ACTION***

1. The application of Goo et al. for the "Method for transmitting short message using Internet phones and system therefor" filed 03/05/2002 has been examined. This application claims Foreign Priority based on the application 2001-54383 filed September 05, 2001 in Republic of Korea. Receipt is acknowledged of papers submitted under 35 U.S.C 119(a) – (d), which papers have been placed of record in the file. Claims 1-15 are pending in the application.

***Claim Rejections - 35 USC ' 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was

Art Unit: 2665

made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-5, 7-9, 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rueger et al. (US#2003/0018806) in view of Back et al. (US#2003/0036396).

With respect to claims 1, 9 and 13-15, Rueger et al. (US#2003/0018806) and Back et al. (US#2003/0036396) disclose a novel system and method for transmitting a short message between Internet phones, according to the essential features of the claims. Rueger et al. (US#2003/0018806) discloses in Fig. 4 a flow chart diagram illustrated the message confirmation for communication of the SMS data between the internet phones, in which the short message is forwarded by the service centre SC to a gateway function GMSC which is a function of a mobile services switching centre MSC. The gateway GMSC is capable of interrogating a home location register HLR which contains routing information to the visitor location register VLR. The visitor location register VLR is the functional unit that attends to a mobile station MS operating outside the area of the home location register. A visiting mobile station MS is automatically registered at the nearest mobile services switching centre MSC and the visitor location register VLR is informed accordingly. Based on the retrieved routing information the gateway GMSC forwards the short message to the visited mobile services switching centre MSC. The visited mobile services switching centre MSC retrieves corresponding subscriber information from the visitor location register VLR based on which the short message is forwarded to the mobile station MS. Operations are terminated by returning a delivery report to the service centre SC of the network where the short message has

been initiated. ([0010]). Rueger further teaches the message server WAMS where corresponding address information of the recipient application and the service centre SC1 connected thereto is retrieved. Based on the information in the database HLRx of the message server WAMS address data corresponding to the virtual mobile station number is retrieved and used for the forwarding of the message as a new destination address. The message is therefore forwarded to the service centre SC1 whose address has been retrieved from the database HLRX with the destination address of the recipient application or a related service ([0046]-[0065]). It's noted that Control of intercommunication between such an internet phone and a telephone in a conventional switched circuit network is standardized by the gateway function provided for by ITU Recommendation H.323 protocol.

However, Rueger et al. (US#2003/0018806) does not expressly disclose the short message transmission module for transmitting via a predetermined port, the short message including information corresponding to a telephone number of an internet phone of a called party. In the same field of endeavor, Back et al. (US#2003/0036396) discloses a method and system for receiving data by using the SMS and the wireless Internet. The method comprises the steps of receiving a short message from said service provider, wherein the short message comprises at least a service identifier and site information, determining whether or not there is an application protocol in the site information and executing an IP channel connecting program in correspondence with the application protocol, when the application protocol is in the site information, wherein the data receiving system receives data in correspondence with the application protocol from the service provider by executing the IP channel connecting program (See Figs. 2-3; [0011]-[0013] and [0030]-[0033]).

Regarding claims 3-4, 11-12, Back et al. (US#2003/0036396) further teaches in Fig. 3 a data format illustrated the data field structure of a short message received from the service provider, in which the data field divider 440 may divide the short messages provided by service provider 100 into data fields. For example, the data field divider 440 may divide the short messages into a service identifier field, a first site information field, a second site information field, and similar fields. The service identifier field may store service identifiers. The first site information fields may store a first application protocol, a first URL and similar data. Also, the second site information fields may store a second application protocol, a second URL and similar data. The size of each field may preferably be assigned in advance (See also Fig. 2; [0036]-[0044]).

Regarding claim 5 and 7-8, they are method claims corresponding to the system claims 1, 9 and 3-4, 11-12 above. Therefore, claims 5 and 7-8 are analyzed and rejected as previously discussed with respect to claims 1, 9 and 3-4, 11-12.

One skilled in the art would have recognized the need for communicating short message service between internet phones using H.323 protocol, and would have applied Back's teaching of the executing an IP channel connecting program correspondence with the application protocol into Rueger's novel use of the message server and a telecommunications network for conveying short message. Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to apply Back's method for receiving data using SMS and wireless internet and system thereof into Rueger's method and message server for conveying messages in a telecommunications network with the motivation being to provide a method and system for transmitting a short message in an internet phones.

5. Claims 2, 6, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rueger et al. (US#2003/0018806) in view of Back et al. (US#2003/0036396) as applied to the claims above, and further in view of Pang et al. (US#2003/0043762).

With respect to claims 2, 10, Rueger et al. (US#2003/0018806) and Back et al. (US#2003/0036396) disclose the claimed limitations discussed in paragraph 4 above. However, these claims differ from the claims above in that the claims require the feature wherein the short message transmission server transmits an ARQ for RAS, and receives an ACF message. In the same field of endeavor, Pang et al. (US#2003/0043762) discloses in Fig. 6 a general flow diagram illustrating the call-making methods, in which the standard H.225 RAS admission request and Q.931 setup procedures are performed. The end terminal, such as a H.323 terminal, transmits a H.225 RAS admission request signal to a GK of the packet data network, which contains the identity of the wireless communication device, such as the phone number of a mobile phone. The GK is able to find the corresponding IP address according to an IP transformation table and responds to the H.323 terminal with an H.225 RAS admission confirmation signal. The H.323 terminal sends, preferably through a GGSN, a Q.931 setup signal to a VMSC in order to establish a voice communication channel. The VMSC in the present invention communicates with the wireless communication device through a circuit-switched network and communicates with the end terminal through a packet-switched network. Upon receiving a setup signal, the GGSN obtains the PDP context of the identified wireless communication device, such as a mobile phone, according to the IP address identified by a packet received from the H.323 terminal. The GGSN then obtains the GPRS Tunnel ID and

Art Unit: 2665

SGSN address of the mobile phone from the PDP context and sends the packet to the VMSC. Upon receiving the Q.931 signal, the VMSC responds to the H.323 terminal with a Q.931 call proceeding signal. The VMSC and GK exchange RAS ARQ and Admission Confirmation ("ACF") signals with each other. The VMSC then sends a communication request, in a similar way as illustrated for step 2.3 ([0059]).

Regarding claim 6, it is a method claim corresponding to the system claims 2 and 10 above. Therefore, claim 6 is analyzed and rejected as previously discussed with respect to claims 2, 10.

One skilled in the art would have recognized the need for facilitating the exchange of data between processing units utilizing UTOPIA protocol, and would have applied Pang's teaching of the call set up procedure between VMSC and the packet data network, and Back's teaching of the executing an IP channel connecting program correspondence with the application protocol into Rueger's novel use of the message server and a telecommunications network for conveying short message. Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to apply Pang's system and method for providing voice communications for radio network, and Back's method for receiving data using SMS and wireless internet and system thereof into Rueger's method and message server for conveying messages in a telecommunications network with the motivation being to provide a method and system for transmitting a short message in an internet phones.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's



disclosure.

The Rueger et al. (US#2004/0053629) is cited to show the method and message server for conveying messages in a telecommunications network.

The Guggisberg (US#2004/0029598) is cited to show the method for transmitting short messages over the internet.

The Kotola et al. (US#6,321,257) is cited to show the method and apparatus for accessing internet service in a mobile communication network.

The Agrawal et al. (US#6,788,660) is cited to show the adaptive mobile signaling for wireless internet telephony.

The Shaheen (US#2005/0282565) is cited to show the reporting terminal capabilities for supporting short message service.

The Smith et al. (US#6,891,811) is cited to show the short messaging service center mobile -originated to HTTP internet communications.

The Miralles et al. (US#2004/0110516) is cited to show the system for interconnecting a remote server with a short message server center (SMSC) via the internet.

The Ray et al. (US#6,067,529) is cited to show the system and method for sending a short message containing purchase information to a destination terminal.

The Thakker (US#6,487,602) is cited to show the system and method for accessing the internet in an IP based cellular network.

The Henry-Labordere (US#6,512,926) is cited to show the dynamic routing system for a short message sent by a calling party using a mobile phone.

Art Unit: 2665

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Phan whose telephone number is (571) 272-3149. The examiner can normally be reached on Mon - Fri from 6:00 to 3:00.

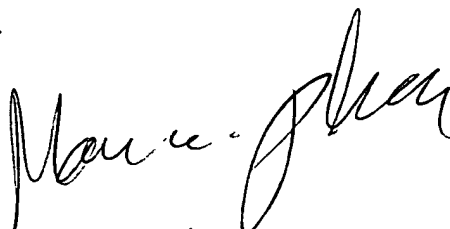
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu, can be reached on (571) 272-3155. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2600.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at toll free 1-866-217-9197.

Mphan

01/24/2006.

  
MAN U. PHAN  
PRIMARY EXAMINER